



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,471	01/28/2004	Hirokazu Sawada	Q78015	9438
23373	7590	04/03/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			GILLIAM, BARBARA LEE	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,471

Applicant(s)

SAWADA ET AL.

Examiner

Barbara L. Gilliam

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 1, 2006 has been entered.
2. Claims 1-21 are present.
3. The claim amendments are fully supported by the specification.
4. The claims are "product-by-process" claims or dependent on product-by-process claims. Applicant is reminded of MPEP 2113: "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

Art Unit: 1752

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 3, 5, 7-8, 10, 11, 12, 14, 15 and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/784,879 (US 2004/0166442 A1).

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to make an aluminum support for a lithographic printing plate obtained by performing graining treatment wherein the support comprises 0.20-0.29% Fe, 0.03-0.15% Si, 0.020-0.040% Cu and 0.050% or less Ti based on the claims of Sawada et al.*

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1, 3, 5, 7-8, 10, 11, 12, 14-15 and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/059,378 (US 2002/0155377 A1).

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to make

Art Unit: 1752

a presensitized plate comprising an aluminum support and a photosensitive layer formed thereon wherein the aluminum plate comprises 0.15-0.5% Fe, 0.03-0.15% Si, 0.003-0.50% Ti and 0.001-0.05% Cu and/or 0.001-0.1% Mg based on the claims of Sawada et al.*

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*The copending published patent applications and patents claim various characteristics presently claimed however, it is the Examiner's position the aluminum alloy supports of the cited published applications and patents inherently have the same characteristics because of the supports contain the same elements in at least overlapping amounts. Applicant is reminded of MPEP 2112 and 2112.01: "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-16, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishikawa et al. (EP 211 574 A1).

a. The aluminum alloy support for lithographic printing plates of Nishikawa et al. anticipates the presently claimed aluminum alloy support. The aluminum alloy support of Nishikawa et al. is produced by cold rolling an aluminum alloy has a thickness of 0.1 to 0.5 mm and is composed substantially of 0.05 to 3% Mg, 0.05 to 0.7% Si, 0.01 to 0.25% Zr, 0.05 to 0.4% Fe (abstract; claims; column 4, lines 39-58) with Cu Zn and Ti as unavoidable impurities in an amount up to about 0.05% (column 3, line 30 – column 4, line 36). The support, when provided with a photosensitive layer (column 6, lines 9-13), anticipates the presently claimed presensitized plate.*

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1752

11. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hotta et al. (EP 1 013 469 A1) in view of Nishikawa et al. (EP 211 574 A1).

a. Hotta et al. teach a process for the preparation of a photosensitive lithographic printing plate. A positive working composition is coated on a support [0059], exposed to light and then subjected to development [0096] which is preferably an alkaline aqueous solution containing at least one saccharide [0097]-[0110]. The support is an aluminum plate can be made of pure aluminum or aluminum alloy comprising aluminum as a main component and a slight amount of foreign elements such as silicon, iron, copper and titanium [0009]. These foreign elements are present in an amount of not greater than 10%, however Hotta et al. do not specifically disclose how much of each foreign element is preferable. Based on the teachings of Nishikawa et al., it would have been obvious to use an aluminum alloy support containing of 0.05 to 3% Mg, 0.05 to 0.7% Si, 0.01 to 0.25% Zr, 0.05 to 0.4% Fe and up to 0.05% Cu (abstract; claims; column 4, lines 39-58; column 3, line 30 – column 4, line 36) with reasonable expectation of obtaining an alloy with high mechanical strength and excellent water retention based on the teachings of Nishikawa et al. - abstract.**

**The cited references teach various characteristics presently claimed however, it is the Examiner's position the aluminum alloy supports of the cited references inherently have the same characteristics because of the supports contain the same elements in at least overlapping amounts. Applicant is reminded of MPEP 2112 and 2112.01: "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old

Art Unit: 1752

composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Response to Arguments

12. Applicant's arguments filed March 1, 2006 with respect to the obviousness-type double patenting rejection over application No. 10/855,868 have been fully considered and are persuasive. The double patenting rejection over said copending application of claims 1, 3, 5, 7-8, 10-11 and 21 has been withdrawn.

13. Applicant's arguments, filed March 1, 2006, with respect to the rejections of claims 1-21 under 35 USC 102(b) (over Suzuki et al.) and 103(a) (over Hotta et al. in view of Suzuki et al.) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection under 35 USC 103(a) is made in view of Hotta et al. in view of Nishikawa et al.

Art Unit: 1752

14. Applicant's arguments filed March 1, 2006 with respect to Nishikawa et al. have been fully considered but they are not persuasive.

a. Applicant argued the presently claimed invention is not anticipated by Nishikawa et al. in light of the amendment to claim 1 wherein the Cu content is 0.025 to 0.050 wt% and that Mg may be contained in an amount of 0.05 wt% or less. The Examiner disagrees. As pointed out in the rejection above, the aluminum alloy support of Nishikawa et al. comprises 0.05 to 3% Mg and up to about 0.05% Cu (column 3, line 30 – column 4, line 36).

15. Applicant argued one of ordinary skill would not have been motivated to modify the references as suggested by the Examiner and argues the importance of Cu. Applicant specifically argued the Cu range of 0.025 to 0.050 wt% and specifically stated that “[s]ince the diameters of pits produced by electrolytic graining treatment in a nitric acid solution can be made higher by setting the content of Cu at 0.025 wt% or more, water retention of fountain solution in the non-image areas can be largely secured when printing is performed after exposure and development, thereby improving scum resistance” and points to page 18 of the specification as support. According to the specification at page 18, scum resistance is improved when the content of Cu is set at 0.020 wt% or higher. Applicant has not shown the criticality of the claimed range of 0.025 to 0.050 wt% Cu – MPEP 716.02(d) II. With respect to Mg, the Examiner notes that Mg is optional, present in an amount of less than 0.05 wt%. Applicant's arguments with respect to Mg cannot take the place of factual evidence – MPEP 716.01 (c) I, II.

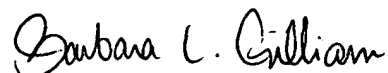
Art Unit: 1752

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
March 20, 2006